

AGILENT TECHNOLOGIES, INC.  
 Legal Department, DL429  
 Intellectual Property Administration  
 P. O. Box 7599  
 Loveland, Colorado 80537-0599

ATTORNEY DOCKET NO. 10030416-1

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FEB 27 2006

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Eric M. Leproust

Serial No.: 10/698,195

Examiner: Katherine D. Salmon

Filing Date: October 30, 2003

Group Art Unit: 1634

Title: METHODS FOR IDENTIFYING SUITABLE NUCLEIC ACID PROBE SEQUENCES FOR USE IN  
 NUCLEIC ACID ARRAYS

COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria VA 22313-1450

## TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

<input checked="" type="checkbox"/> Response/Amendment	<input type="checkbox"/> Petition to extend time to respond
<input type="checkbox"/> New fee as calculated below	<input type="checkbox"/> Supplemental Declaration
<input checked="" type="checkbox"/> No additional fee (Address envelope to "Mail Stop Amendments")	
<input type="checkbox"/> Other:	(Fee \$ _____)

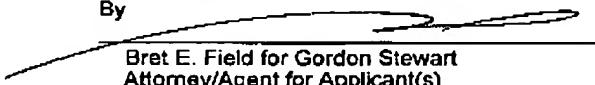
CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM						+ 360
EXTENSION FEE	1 <sup>ST</sup> MONTH 120.00	<input type="checkbox"/>	2 <sup>ND</sup> MONTH 450.00	<input type="checkbox"/>	3 <sup>RD</sup> MONTH 1020.00	<input type="checkbox"/>
					4 <sup>TH</sup> MONTH 1590.00	<input type="checkbox"/>
					OTHER FEES	\$ 0
					TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	\$ 0

Charge \$0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Eric M. Leproust

By

  
 Bret E. Field for Gordon Stewart  
 Attorney/Agent for Applicant(s)

Reg. No. 37,620

Date: 02-27-2006

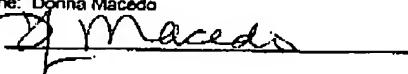
Telephone No. (650) 485-2864

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:

571-273-8300

Date of facsimile: 02-27-2006

Typed Name: Donna Macado

Signature: 

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**FEB 27 2006**

<b>VIA FACSIMILE 571-273-8300</b>		
<b>RESPONSE TO RESTRICTION REQUIREMENT</b>	Attorney Docket Confirmation No.	10030416-1 3542
Address to: Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450	First Named Inventor	Eric M. Leproust
	Application Number	10/698,195
	Filing Date	October 30, 2003
	Group Art Unit	1634
	Examiner Name	Katherine D. Salmon
	Title	Methods for Identifying Suitable Nucleic Acid Probe Sequences for Use in Nucleic Acid Arrays

Dear Sir:

This communication is responsive to the office communication dated February 10, 2006.

In the above referenced office communication, the Examiner imposed a restriction requirement, requiring the election of the claims of either:

Group I, i.e., Claims 1-10, 13-15 and 22;

Group II, i.e., Claims 11-12;

Group III, i.e., Claim 16;

Group IV, i.e., Claims 17-20;

Group V, i.e., Claim 21; or

Group VI, i.e., Claim 23;

for further prosecution in this application.

The Applicants hereby elect Group I with traverse.

The Applicants also respectfully urge the Examiner to rejoin the claims of Groups II-VI with the elected claims of Group I for examination in this application for the following reasons.

The MPEP allows an Examiner to examine otherwise patentably distinct sets of claims if to do so would not impose an undue burden on the Examiner. M.P.E.P. § 8.03 states that:

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**If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.**

In the present case, the claims of Groups II-VI are directed to articles for use in performing the methods of Group I, as well as articles and use thereof of the product of the methods of Group I. As such, the search for the claims of Group I will find any relevant prior art relating to the claims of Groups II-VI.

Accordingly, little, if any, additional searching should be required for the claims of Groups II-VI, and therefore the examination of the claims of Groups II-VI together with the claims of elected Group I should impose little, if any, additional burden on the Examiner.

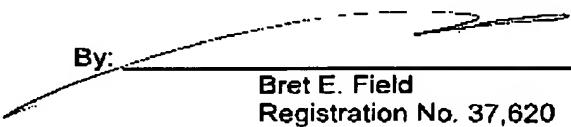
As such, examining the claims of Groups II-VI and the claims of elected Group I together in the present application clearly does not impose an undue or serious burden on the Examiner. In the absence of such an undue or serious burden, the Examiner is clearly instructed by the MPEP to examine the entire application. Therefore, the Examiner is respectfully requested to rejoin the claims of Groups II-VI with the claims of elected Group I and to examine all the claims together in the present application.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: 2. 27. 06

By:

  
Bret E. Field  
Registration No. 37,620

AGILENT TECHNOLOGIES, INC.  
Intellectual Property Administration, Legal Dept.  
P.O. Box 7599  
M/S DL429  
Loveland, Colorado 80537-0599

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